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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,529	06/27/2005	David Andrew Parker	TPP 31765	7022
24257	7590	02/06/2008	EXAMINER	
STEVENS DAVIS MILLER & MOSHER, LLP			PEPITONE, MICHAEL F	
1615 L STREET, NW			ART UNIT	PAPER NUMBER
SUITE 850				
WASHINGTON, DC 20036			1796	
MAIL DATE	DELIVERY MODE			
02/06/2008	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/534,529	PARKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MICHAEL PEPITONE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) 5 and 13 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/ are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/30/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 5 and 13 are objected to because of the following informalities: Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A, B and C.” See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925) [See MPEP 2173.05(h)]. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18: Claim 18 is indefinite as it depends from claim 19. For the purpose of further examination, claim 18 was interpreted as depending from claim 17.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Takayama *et al.* (US 6,326,435).

Regarding claims 1-4, and 26: Takayama *et al.* teaches a method of using a slip agent in a polyester composition (1:4-10) with improved sliding characteristics (2:24-29) comprising polyester (4:36-61), specifically polyethylene terephthalate (4:45), and an aliphatic acid ester of a (C<sub>10</sub>-C<sub>30</sub>) fatty acid and (C<sub>8</sub>-C<sub>30</sub>) aliphatic alcohol {slip agent} (6:65-7:55, 8:17-27, tables 1 and 3) [instant claims 1-4 and 26].

Regarding claim 5: Takayama *et al.* teaches the basic claimed method [as set forth above with respect to claim 1], wherein the slip agent is behenyl behenate (7:60-65).

Regarding claim 6: Takayama *et al.* teaches the basic claimed method [as set forth above with respect to claim 1], wherein the polyester is polybutylene terephthalate (4:41-45).

Regarding claims 7-8: Takayama *et al.* teaches the basic claimed method [as set forth above with respect to claim 1], wherein the slip agent is present in the PET polymer in an amount of 0.2 to 8 parts by weight (8:17-27).

Claims 9-20, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Takayama *et al.* (US 6,326,435).

Regarding claims 9-12, and 27: Takayama *et al.* a polyester composition (1:4-10) with improved sliding characteristics (2:24-29) comprising polyester (4:36-61), specifically polyethylene terephthalate (4:45), and an aliphatic acid ester of a (C<sub>10</sub>-C<sub>30</sub>) fatty acid and (C<sub>8</sub>-

C<sub>30</sub>) aliphatic alcohol {slip agent} (6:65-7:55, 8:17-27, tables 1 and 3) [instant claims 9-12 and 27].

Regarding claim 13: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claim 9], wherein the slip agent is behenyl behenate (7:60-65).

Regarding claim 14: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claim 9], wherein the polyester is polybutylene terephthalate (4:41-45).

Regarding claims 15-16: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claim 9], wherein the slip agent is present in the PET polymer in an amount of 0.2 to 8 parts by weight (8:17-27).

Regarding claim 17: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claim 9], the slip agent is incorporated into the polymer composition (10:10-30).

Regarding claim 18: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claims 9 and 17], wherein the polyester is polybutylene terephthalate (4:41-45).

Regarding claims 19-20: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claims 9 and 17], wherein the slip agent is present in the PET polymer in an amount of 0.2 to 8 parts by weight (8:17-27).

Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Takayama *et al.* (US 6,326,435).

Regarding claim 25: Takayama *et al.* teaches polyester composition (1:4-10) with improved sliding characteristics (2:24-29) comprising a copolymer of polyester (4:36-61), specifically polyethylene terephthalate (4:45), and an aliphatic acid ester of a (C<sub>10</sub>-C<sub>30</sub>) fatty acid and (C<sub>8</sub>-C<sub>30</sub>) aliphatic alcohol {slip agent} (6:65-7:55, 8:17-27, tables 1 and 3) [instant claim 25].

Claims 9, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanno (US 5,998,005).

Regarding claims 9, 23-24: Kanno teaches a sheet {film} made of a polyester composition (1:4-10) comprising a copolymer of poly(ethylene terephthalate) and poly(cyclohexanedimethylene terephthalate) (2:1-27), and a fatty acid ester lubricant {slip agent}, specifically cetyl palmitate (2-39:45) [instant claims 9, 23-24 and 27].

Claims 9 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Zierer *et al.* (US 5,741,586).

Regarding claims 9 and 21: Kanno teaches a bottle {container}(6:37-43) made of a polyester composition (1:4-8) comprising a (co)polymer of aliphatic and cycloaliphatic polyester (1:40-46; 1:54-2:50), and a fatty acid slip agent, specifically ethyleneglycol distearate (1:12-15) [instant claims 9 and 21].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama *et al.* (US 6,326,435), as applied to claim 9 above.

Regarding claims 21, and 23-24: Takayama *et al.* teaches the basic claimed composition [as set forth above with respect to claim 9]. Takayama *et al.* does not teach a bottle made from a polymer of instant claim 9 [claim 21], or film made from a polyester of instant claim 9 [claim 23], specifically the polyesters listed in instant claim 24. However, at the time of invention a person of ordinary skill in the art would have found it obvious to have made polyester bottles [instant claim 9] and poly(ethylene terephthalate) films [instant claims 23-24], as commonly practiced in the art, based on the invention of Takayama *et al.*, and would have been motivated to do so since Takayama *et al.* suggests that the composition is useful in making shaped articles (1:7-10), and is an equivalent alternative means of providing polyester bottle or film comprising a slip agent.

Art Unit: 1796

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

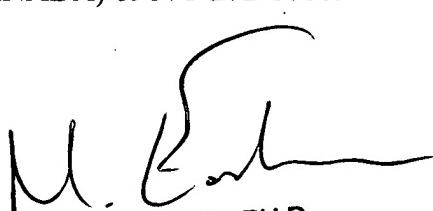
***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MFP  
31-January-08

  
MARK EASHOO, PH.D.  
SUPERVISORY PATENT EXAMINER

01/Feb/08